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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,643	11/28/2000	Hirofumi Wada	33216M061	4571

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EXAMINER

CHEVALIER, ROBERT

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,643

Applicant(s)

WADA ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5-6</u> . | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The abstract of the disclosure is objected to because it contains too many paragraphs and because it contains the term "means". Correction is required. See MPEP § 608.01(b).
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (Figures 18-21, and 2) described at pages 1-11 of the present Application in view of Wood et al.

The admitted prior art (Figure 18-21, and 2) of the present Application discloses a program recording apparatus that shows substantially the same limitations recited in claims 1-2, and 11-13, including the feature of inputting program information concerning programs (See the admitted prior art Figure 18, component 20, of the present Application), the feature of the setting means for the setting of the recording of programs (See the admitted prior art Figure 18, components 250, of the present Application), the feature of the recording means for writing in, and erasing data containing the contents of the programs to and from a recording medium (See the admitted prior art Figure 18, components 60, and 261), the feature of the management means for storing program information which is inputted from the program information input means and for recording said programs by the recording means according to the setting for recording or independent of the setting for recording (See the admitted prior art Figure 18, components 240, and 41, and Figure 19, of the present Application), the feature of the management means predicting a shortage of vacant space in the recording medium at the point in time when the recording means carries out the writing in of the data containing the contents of said program, of which the recording is set, to

the recording medium by referring to program management information including at least the program information, the recording status of the recording medium and recording setting status of the programs and in the case said vacant space is in shortage, decides the programs to be erased at the point in time when said writing in is carried out among the programs which have already been recorded or which have already been set for recording according to a predetermined criteria as specified in the present claims 1-2, and 11-13. (See the admitted prior art described at pages 10-11 of the present Application).

The admitted prior art Figures 18-21 of the present Application fails to specifically disclose the feature of erasing according to the predetermined criteria including a criterion concerning the erasure possibility at the point in time when the writing in of the program is carried out as specified in the present claims 1-2, and 11-13.

Wood et al does disclose a program recording apparatus which includes the feature of erasing according to the predetermined criteria including a criterion concerning the erasure possibility at the point in time when the writing in of the program is carried out as specified in the present claims 1-2, and 11-13. (See Wood et al's column 4, lines 36-41).

It would have been obvious to one skilled in the art to modify the recording apparatus of the admitted prior art of the present Application (Figure 18) wherein the recoding/erasing means provided thereof would incorporate the feature of erasing according to the predetermined criteria including a criterion concerning the erasure possibility at the point in time when the writing in of the program is carried out in the

same conventional manner as shown by Wood et al. The motivation is to avoid erasing recorded programs that are of interest to the user as suggested by Wood et al.

With regard to claim 3, the feature of the determination of the programs to be erased being carried out by utilizing a criterion concerning the program management information and the erasure possibility as specified thereof would be present in the proposed combination indicated above. Since, Wood et al discloses that recorded shows are selected for erase based on a priority criteria and that such a priority criteria are determined based on user provided priority information which would be stored in management area. (See Wood et al's column 4, lines 36-41, and 28-30).

With regard to claim 4, the feature of determining the program to be erased by utilizing the history of recording operation which is carried by the recording means as specified thereof is present in the proposed combination indicated above. (See Wood et al's column 4, lines 47-50).

With regard to claims 5-6, and 14, the feature of determining the erasure possibility of the programs by utilizing any of broadcast start date, and time, broadcast time, number of viewings and types of the programs which have been recorded or have been set for recording as specified thereof would be present in the proposed combination indicated above. (See Wood et al's column 4, lines 49-50, and the admitted prior art described at page 10, lines 1-2, of the present Application).

With regard to claim 7, the feature of freely changing the predetermined criteria as specified thereof is present in the proposed combination indicated above. (See Wood et al's column 10, lines 47-56).

With regard to claims 8-9, the feature of the electronic program information specified thereof is present in the proposed combination indicated above. (See the admitted prior art Figure 18, component 20, and Figure 2, of the present Application).

With regard to claim 10, the feature of an indication of cancellation of the setting for recording by the user being necessary in order to cancel the setting for recording of said programs which have been set for recording of which criterion concerning the erasure possibility is non-erasable as specified thereof would be inherently present in the proposed combination indicated above since conventional VCR such as the ones shown in the proposed combination indicated above would include a stop button for the purpose of stopping any operations of the recording apparatus at any desired time.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 703-305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
August 8, 2004.


ROBERT CHEVALIER
PRIMARY EXAMINER